REMARKS/ARGUMENTS

This paper responds to the Office Action of June 21, 2004. Applicant respectfully requests reconsideration of the application.

Claims 1-53 are now pending, a total of 53 claims. Claims 1, 2, 7, 14, 20, 23, 30, 35, 41, 44 and 49 are independent. Of these, claims 1, 23, 30, 44 and 49 are allowed, or indicated as reciting allowable subject matter. Further dependent claims are also indicated as allowable.

The amendments to claim 1 merely correct an obvious typographical error, and have no effect on the claim's scope.

I. Preliminary Amendment

Applicant requests confirmation that a Preliminary Amendment filed on March 30, 2001 (making eight amendments to the specification) was received and entered.

II. Claims 2, 7, 14 and 20

Claim 2 is compared to certain portions of Yeh '750 in paragraph 5 of the Office Action. Claim 2 recites as follows:

> 2. A method comprising the steps of:
> decoding a macroinstruction of a computer, the decoding of the macroinstruction generating a number of iterations of:
>> a pattern of microinstructions implementing a basic operation, and
>> a branch instruction predicted not taken.

Claim 2 recites "a macroinstruction" (singular) that generates "a number of iterations" (plural) of microinstructions. The indicated portions of Yeh '750 do not mention "microinstructions" or "macroinstructions," let alone decoding or executing iterations of microinstructions within a single macroinstruction.

Because the Office Action only indicates large ranges of Yeh's specification, without indicating which particular element of Yeh '750 is thought to be pertinent to the "macroinstruction," which to the "iteration," and which to the "microinstructions" of the claim (as required by 37 C.F.R. § 1.104(c)(2)), Applicant is unable to respond more directly.

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Because claim 2 recites a limitation absent from the indicated portions of Yeh '750, any § 102 rejection may be withdrawn.

Claims 7, 14 and 20 recite similar limitations and are patentable for similar reasons.

III.   Claims 35 and 41

Paragraph 8 of the Office Action mentions claim 35 in summary fashion, but no portion of the Office Action provides an element-by-element comparison of claim 35 to the prior art. No rejection exists.

Claim 35 recites as follows:

> 35. A method comprising the steps of:
>
> in a computer having instruction fetch circuitry for fetching instructions in first and second instruction sets from a memory of the computer and executing the instructions, executing a first instruction coded in the first instruction set, the first instruction storing into a memory location a value of a second instruction coded in the second instruction set,
>
> in response to the storing, clearing an instruction cache and execution pipeline of the computer of the former content of the memory location;
>
> executing the second instruction in the execution pipeline.

A review of the portions of Yeh '750 indicated for the other claims reveals nothing that would correspond to claim 35. Without some comparison of the claim language to the prior art, Applicant is unable to respond more directly.

Claim 41 recites similar language, and is similarly not rejected.

IV.   Inherency

Certain portions of the Office Action simply state that some feature is "inherent" in Yeh '750. Reliance on inherency is governed by MPEP § 2112(IV), which reads as follows (citations omitted):

IV. EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by

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probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " ...

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." ...

Here, the Office Action makes a bald assertion of "inherency," but provides no "basis in fact and/or technical reasoning to reasonably support" the assertion. No rejection exists.

Further, there is no reason to believe that Yeh "necessarily" decodes macroinstructions into microinstructions, because Yeh '750 could well be directed to a computer that directly executes at least some instructions, without macroinstruction-to-microinstruction decoding.

V.   Dependent claims

The dependent claims are patentable with the independent claims discussed above. In addition, the dependent claims recite additional features that further distinguish the art.

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely.
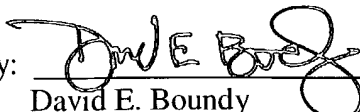
Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 23-2405, Order No. 114596-31-0127BS.

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

Dated: <u>September 21, 2004</u>   By: _____

David E. Boundy
Registration No. 36,461

WILLKIE FARR & GALLAGHER LLP
787 Seventh Ave.
New York, New York 10019
(212) 728-8000
(212) 728-8111 Fax

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